

Application No. 10/826,651
Response to 24 March 2005 Non-Final Office Action

REMARKS

Claims 1-37 are pending. By this Amendment, no claims are canceled, amended, or added.

For reasons stated herein, reconsideration and withdrawal of the rejection are respectfully requested.

35 U.S.C. § 103

1. Claims 1-37 are rejected under 35 U.S.C. § 103(a) as obvious over WO 99/35446 ("Morris"), in view of U.S. 6,298,613 ("Coulton et al."). The rejection states that the "roof ridge vent of Morris is identical to the present claims." Then admits "Morris does not show a filter material secured to the bottom surface of the vent part." Then asserts that "[p]atents to Coulton et al teach a roof ridge vent with filter (44 or 50, respectfully) secured to the bottom surface of the vent part same as claimed." The rejection then concludes "[t]herefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Morris (Fig. 15) with the filter of Coulton." The rejection then seems to offer as motivation for the proposed modification "in order to increase the ventilation efficiency." Applicant respectfully traverses this rejection.

In order to establish a prima facie case of obviousness, a rejection must cite documents which teach or suggest all the claim limitations¹ and establish a proper motivation for modifying the documents cited against the claims. The motivation to modify the documents cited against

¹ See M.P.E.P. 2143 ("To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.").

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the claims must be present in the documents themselves or otherwise in the prior art, not in the instant application^{2,3} and must be "clear and particular."⁴ That the disclosures of the documents cited against the claims can be modified or that the asserted modification is within the ability of a person of ordinary skill in the art is not sufficient to establish the required motivation.^{5,6} Indeed, logic and sound reasoning in the absence of a motivation are also insufficient to establish a prima facie case of obviousness.⁷ Moreover, neither conclusory statements within the rejection nor

² See M.P.E.P. § 2142 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.").

³ Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985) ("Regarding an invention directed to a combination of known elements, the Board indicated that the examiner had done little more than cite references showing that elements or subcombinations of them were known. To support a conclusion of obviousness, 'either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.'").

⁴ See In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[The] district court's conclusion of obviousness was error when it 'did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination.' [citations omitted] ... The range of sources available, however, does not diminish the requirement for actual evidence. That is the showing must be clear and particular.") (emphasis added).

⁵ See M.P.E.P. § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.").

⁶ See M.P.E.P. 2143.01 ("A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' 'because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also, In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.")) (emphasis added).

⁷ Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Int. 1993) ("That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.").

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subjective opinion stated in the rejection are sufficient to establish the required motivation to modify the documents cited against the claims.⁸ Similarly, if the rejection asserts that the motivation was generally present in the art at the time of the invention, the rejection then asserts facts alleged to be known to the Examiner. These facts known to the Examiner must themselves be stated for the record. Thus, the Examiner may be required to execute an affidavit or declaration to that effect so that the Applicant may have the opportunity to explain or dispute the assertions therein.⁹ Additionally, evidence of patentability is established if the disclosures of the cited documents actually teach away from the asserted modification.¹⁰

Applicants respectfully submit that a prima facie case of obviousness has not been established because the proper motivation to modify the disclosure of Morris with the disclosure

⁸ See, In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed Cir. 2002) ("The examiner's conclusory statements that the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software and that another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.") (internal quotation marks omitted) (emphasis added).

⁹ See M.P.E.P. § 2144.03 ("As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. In re Zurko, 59 USPQ2d 1693, 1697.... If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) [When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons].") (emphasis added).

¹⁰ See MPEP § 2155.05 III ("A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)").

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of Coulton et al. has not been shown. Applicants respectfully submit that neither Morris nor Coulton et al. disclose or suggest that the "filter" of Coulton et al. would improve "ventilation efficiency." In fact, the rejection fails to cite any portion of Morris or Coulter et al. supporting the proposed modification. To the contrary, Coulton et al. refers to US Patent 5,960,595 as disclosing the openwork mat made from randomly convoluted polymeric filaments.¹¹ US Patent 5,960,595, in turn, states "the fabric backing is supported on the exterior of the 'cusps,' it does not intrude into the inner structure of the present laminate so as to restrict the desired airflow through the laminate construction."¹² Applicants respectfully submit that not restricting desired airflow is not improving ventilation efficiency. Improving ventilation efficiency would conceivably involve improving airflow through the vent. As stated above, neither Coulton et al. nor Morris disclose or suggest improving airflow, or ventilation efficiency, by the presence of the filter of Coulton et al. Because no portions of Morris or Coulton et al. support the proposed modification, a prima facie case of obviousness has been established.

As explained above, the unsupported opinion in the rejection that the presence of the filter of Coulter et al. would improve the efficiency of the ventilation of the device of Morris is not sufficient to establish the required motivation. Because the opinion of the Examiner is not sufficient to establish the required motivation, a prima facie case of obviousness is not present.

If the Examiner maintains the rejection by failing to provide objective evidence within Coulton et al. or Morris, the Examiner is respectfully required to execute an affidavit or a

¹¹ Coulton et al. column 3, line 3 et seq. ("According to the preferred embodiment of the present invention, the mat is an openwork mat made from randomly convoluted polymeric filaments as disclosed in U.S. Pat. No. 5,960,595.").

¹² U.S. 5,960,595, column 3, line 22 et seq.

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declaration for the record asserting that the motivation was generally present in the art at the time of the invention. Applicants reserve the opportunity to explain or contradict any affidavit or declaration executed by the Examiner in subsequent proceedings.

Additionally, Applicants respectfully submit that the rejection fails to establish the required and specific motivation for securing the claimed filter material "to the bottom surface of the at least one vent part and to the top panel," as recited in claim 1; for attaching the claimed air permeable filter "to the bottom surface of the top panel and positioned to filter air being conveyed through the top panel air passages or the vent air part air passages," as recited in claim 13; extending the claimed filtering material "between the top panel and the bottom surface of one of the vent parts," as recited in claim 14; "allowing air exchange between the structure interior and the environment via the top panel air passages, the vent part air passages, and the filter material," as recited in claim 15; "securing an air permeable filter material to an interior surface of the top panel and to the vent part," as recited in claim 16; and "the filter material secured to the bottom surface of the vent part and to the top panel," as recited in claim 26. Because the rejection has failed to establish the required motivation to modify the disclosure of Morris with the disclosure of Coulton et al., a prima facie case of obviousness has not been established a fortiori.

Because a clear and particular motivation to modify the disclosure of Morris with the disclosure of Coulton et al. has not been established, a prima facie case of obviousness has not been established with respect to the rejected claims. Because a prima facie case of obviousness has not been established, reconsideration and withdrawal of the rejection are respectfully requested.

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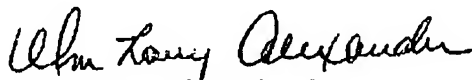
Double Patenting

2. Claims 1-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 29-41, 45-53, and 55-66 of copending U.S. Patent Application 10/636,178. Applicants respectfully traverse this rejection. However, in order to advance the prosecution of this Application, a terminal disclaimer is enclosed. In view of the enclosed terminal disclaimer, withdrawal of the provisional rejection is respectfully requested.

Conclusion

In view of the foregoing, it is submitted that this Application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. To this end, the Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


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